

REMARKS

Specification support for the limitations in the amended and new claims is shown in the following table:

LIMITATIONS/CLAIMS	SPECIFICATION SUPPORT
An emulsion ...in an essential oil and a surface active agent...emulsion ...	Page 3, lines 14 through 21 and original claim 22.
...surface active agent...	Original claim 6.
...comprising a naturally occurring azadirachtin and an essential oil...comprising a naturally occurring surface active agent and a naturally occurring ultraviolet light blocking or absorbing agent...	Page 6, lines 12 through 18; page 5, lines 6 through 20; page 4, lines 17 through 23.
Claim 27.	Page 3, lines 9 through 12.
Claim 28.	Page 3, lines 9 through 11.
Claim 29.	Page 6, line 16.
Claim 30.	Page 6, line 14.

Accordingly, no prohibited new matter has been added and entry of the amendment to the claims and the new claims is requested respectfully.

I. Summary of the Office Action

Election of Group I claims 1-23, has been acknowledged and claims 24-25 have been withdrawn from further consideration by the Examiner.

Claim 26 stands objected to under 37 C.F.R. §1.75(c) as allegedly being improperly multiply-dependent and has not been further treated on the merits.

Claims 1-23 stand objected to because they are alleged to contain spelling errors and errors in punctuation.

Claim 15 stands objected to under 35 U.S.C. §112, second paragraph, for allegedly failing to point out and distinctly claim the invention.

Claim 1 stands rejected under 35 U.S.C. §102(b) as allegedly being anticipated by Wan et al.

Claims 1-5, 14-15 and 17-18 stand rejected under 35 U.S.C. §102(b) as allegedly being anticipated by Guerrini.

Claims 1-4, 6, 10-12, 19, 20 and 22 stand rejected under 35 U.S.C. §102(b) as allegedly being anticipated by Carter et al.

Claim 22 stands rejected under 35 U.S.C. §102(b) as allegedly being anticipated by WO 92/19616.

Claims 5, 13-15, 17-18 and 21 stand rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Carter et al. combined with Guerrini, in view of Butler.

Claims 7-9 stand rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Carter et al. combined with Guerrini, in view of Butler and further in view of Stetter et al., Kulperger, Nakayama, et al. and Liang et al.

Claims 16 stands rejected under 35 U.S.C. §103(a) as allegedly being unpatenatable over Carter et al. combined with Guerrini, in view of Butler and further in view of Jitoe et al.

II. Summary of the Response

Applicants affirm the election of Group I claims 1-23 and 26. Claims 1-5, 7-9, 11-21, 23 and 26 have been amended and claims 27-30 have been added to more clearly describe the present invention. As such, Applicants have added no prohibited new matter.

Applicants traverse the outstanding objections/rejections against pending claims 1-23 and 26 and as they might be applied to new claims 27-30.

III. Objections Under 37 C.F.R. §1.75(c)

Claim 26 stands objected to under 37 C.F.R. §1.75(c) as allegedly being in improper form because a multiple dependent claim cannot depend from any other multiple dependent claim.

While not acquiescing to the reasoning offered in the Office Action, to expedite examination to allowance, Applicants have amended claim 26 which substantially complies with 37 C.F.R. §1.75(c).

With respect to claim 8, Applicants appreciate the suggestion offered by the Examiner and have amended the claim accordingly.

Therefore, Applicants respectfully request that the objections be withdrawn for the reasons, *supra*.

IV. Rejection Under 35 U.S.C. §112, Second Paragraph

Claim 15 stands rejected under 35 U.S.C. §112, second paragraph, for allegedly failing to point out and distinctly claim the invention. The Examiner suggests that the claim recites improper Markush language.

While not acquiescing to the correctness of the reasoning offered in the Office Action, to expedite examination to allowance, Applicants have amended claim 15 to substantially comply with 35 U.S.C. §112, second paragraph.

Accordingly, Applicants respectfully request that the rejection be withdrawn for the reasons, *supra*.

V. Rejections Under 35 U.S.C. §102(b)

A.) Claim 1 stands rejected under 35 U.S.C. §102(b) as allegedly being anticipated by Wan et al. Applicants, respectfully, traverse the rejection as it applies to claim 1 including that it does not apply to new claims 27-30, for the reasons given below.

Wan et al. do not teach an emulsion. Hence, the rejection can be withdrawn.

Further, as claims 27-30 are dependent from claim 23, and as Wan et al. was not applied as an anticipatory reference against claim 23, Wan et al. does not anticipate claims 27-30.

Accordingly, Applicants respectfully request that the rejection be withdrawn for the reasons given above and submit that the rejection does not apply to new claims 27-30.

B.) Claims 1-5, 14-15 and 17-18 stand rejected under 35 U.S.C. §102(b) as allegedly being anticipated by Guerrini. Applicants, respectfully, traverse the rejection as it applies to claims 1-5, 14-15 and 17-18, including that it does not apply to the new claims 27-30, for the reasons given below.

The Examiner suggests that Guerrini teaches "a pesticidal composition containing azadirachtin and an antioxidant such as vitamin C (page 4)." Further, the Examiner alleges that while the composition may contain other ingredients, such a composition may be limited to the azadirachtin and the vitamin C.

However, closer inspection of the disclosure at page 4, lines 1-11 reveals that the minimum constituents of the composition of Guerrini must contain at least azadirachtin, wool wax fatty acids, vitamin C, detergent and water.

“A preferred preparation is azadirachtin...wool wax fatty acids... antioxidants including..., vitamin C...a detergent and water.”

More importantly, the reference is silent with respect to essential oil. As such, the disclosure does not teach the instant invention as claimed.

Further, the Examiner alleges that Guerrini teaches a composition where azadirachtin is present at a concentration of 0.1 to 99 parts by weight and vitamin C is present at a concentration of 1 to 99.8 parts by weight, citing page 6 for support.

However, the claims as amended recite an emulsion comprising azadirachtin, an essential oil, a surface active agent and an antioxidant at particular concentrations. Guerrini does not teach these enumerated materials in the concentrations as presently claimed.

As stated in *Hybritech, Inc. v. Monoclonal Antibodies, Inc.*, 802 F.2d 1367, 231 USPQ 81 (Fed. Cir. 1986):

“It is axiomatic that for prior art to anticipate under 102 it has to meet every element of the claimed invention.”

Thus, because Guerrini does not teach every element as claimed nor the concentrations for the enumerated elements as claimed, the reference does not anticipate the claimed invention.

Further, as claims 27-30 are dependent from claim 23, and as Guerrini was not applied as an anticipatory reference against claim 23, Guerrini does not anticipate claims 27-30.

Accordingly, Applicants respectfully request that the rejection be withdrawn for the reasons given above and submit that the rejection does not apply to new claims 27-30.

C.) Claims 1-4, 6, 10-12, 19, 20 and 22 stand rejected under 35 U.S.C. §102(b) as being allegedly being anticipated by Carter et al. Applicants, respectfully, traverse the rejection as it applies to claims 1-4, 6, 10-12, 19, 20 and 22, including that it does not apply to new claims 27-30 for the reasons given below.

Carter et al. do not teach an emulsion containing an essential oil. Hence, the rejection can be removed. Further, as claims 27-30 are dependent from claim 23, and as Carter et al. was not applied as an anticipatory reference against claim 23, the reference does not anticipate claims 27-30.

Accordingly, Applicants respectfully request that the rejection be withdrawn for the reasons given above and submit that the rejection does not apply to new claims 27-30.

Claim 22 stands rejected under 35 U.S.C. §102(b) as allegedly being anticipated by WO 92/19616. Applicants, respectfully, traverse the rejection as it is applied to claim 22, including that it does not apply to new claims 27-30.

While not acquiescing to the correctness to the reasoning offered in the Office Action, to expedite examination to allowance, Applicants have cancelled claim 22. As such, the rejection is moot with respect to claim 22.

Further, as new claims 27-30 are dependent from original claim 23, and the alleged anticipatory reference (WO 92/19616) was not cited against claim 23, said reference should not be applied as a anticipatory reference against said new claims 27-30.

For these reasons, Applicants respectfully request that the rejection be withdrawn as moot against claim 22 and submit that said reference does not apply to new claims 27-30.

VI. Rejections Under 35 U.S.C. §103

A.) Claims 5, 13-15, 17-18, and 21 stand rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Carter et al. combined with Guerrini, in view of Butler.

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the

reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must be found in the prior art and not based on Applicant's disclosure (M.P.E.P §706.02(j)).

The Examiner suggests that Carter et al. teach a composition containing azadirachtin, a UV light absorbing agent and a surface acting agent. Further, the composition of Carter et al. is asserted not to include an antioxidant nor expressly recited surface active agents.

The Examiner also suggests that Guerrini teaches azadirachtin compositions comprising vitamin C in concentrations alleged to embrace the concentrations as presently claimed and that Butler teaches stabilization of azadirachtin using antioxidants. Thus, the teachings of Guerrini and Butler allegedly cure the deficiencies asserted for Carter et al.

Review of Carter et al. shows that the inventive concept focuses on increased stability using aprotic solvents (see e.g., column 1, lines 61-65 and column 2, lines 1-10), more specifically the reference teaches the avoidance of protic solvents to increase the shelf life stability of azadirachtin compositions (see e.g., column 1, lines 49-51).

Moreover, specific solvent classes to be avoided are enumerated, e.g., acids, bases and especially water (column 2, lines 22-23). Thus, the inventive concept of Carter et al. "is to provide a storage stable neem seed extract formulation having azadirachtin...where in the formulation is characterized by incorporating solvents which are non-degrading toward azadirachtin." Therefore, attempts to combine such teachings with other references that use protic solvents "may be said to teach away when a person of ordinary skill, upon reading the reference, would be discouraged from following the path set out in the reference..." In re Gurley, 27F.3d 551, 31 USPQ2d 1130(Fed. Cir. 1994).

Accordingly, as Guerrini teaches azadirachtin compositions containing water and acids (i.e., protic solvents), one of ordinary skill in the art would not be motivated to combine the reference with Carter et al., since the latter reference teaches that protic solvents decrease azadirachtin stability (i.e., one of skill would be discouraged from following the path set out in Carter et al.). Moreover, this teaching away is not cured by Butler.

As such, the Examiner has not met the burden to establish a prima facie case of obviousness.

Respectfully, Applicants request that the rejection be withdrawn for the reasons given above. Further, for these same reasons, Applicants submit that the rejection does not apply to new claims 27-30.

B.) Claims 7-9 stand rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Carter et al. combined with Guerrini, in view of Butler and further in view of Stetter et al., Kulperger, Nakayama et al., and Liang et al.

The Examiner alleges that Stetter et al., Kulperger, Nakayama et al. and Liang et al. all disclose that specific enumerated compounds have surfactant properties and that one of ordinary skill would use the compounds as such.

However, none of the cited references in the present rejection provide a motivation to use protic solvents in view of the explicit teachings of Carter et al. (i.e., none of the references cure the "teaching away").

Accordingly, the Examiner has not met the burden of establishing a prima facie case of obviousness. For these reasons, Applicants respectfully request that the rejection be withdrawn. Further, Applicants submit that the rejection does not apply to new claims 27-30 for the reasons given above.

C.) Claim 16 stands rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Carter et al. combined with Guerrini, in view of Butler and further in view Jitoe et al.

The Examiner alleges that Jitoe et al. disclose antioxidant containing tropical gingers, including Curcuma and Zingiber.

Again, as above, Jitoe et al. does not provide a motivation to use protic solvents in view of the explicit teaching of Carter et al. (i.e., Jitoe et al. does not cure the "teaching away").

Accordingly, the Examiner has not met the burden of establishing a prima facie case of obviousness. For these reasons, Applicants respectfully request that the rejection be withdrawn. Further, Applicants submit that the rejection does not apply to the new claims 27-30 for the reasons given above.

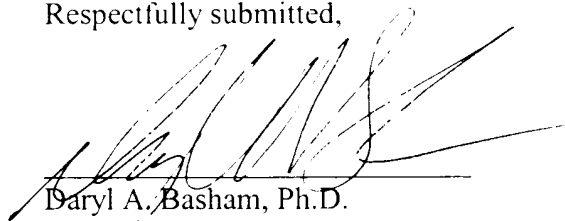
Applicant: Sistla R. MOORTY et al.
Application No. 09.808,970

CONCLUSION

Applicants submit that the claims pending are in condition for allowance. If any fees are found to be applicable, please charge any additional fees or make any credits to Deposit Account No. 07-1896.

Respectfully submitted,

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